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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,850	03/31/2005	Hank F. Kung	1694.0460002/JMC/BLS	5851
23377 7590 07/10/2008 WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			EXAMINER JONES, DAMERON LEVEST	
			ART UNIT 1618	PAPER NUMBER
			MAIL DATE 07/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,850	Applicant(s) KUNG ET AL.	
	Examiner D. L. Jones	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/8/08 & 3/31/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 16-33, 35 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGEMENTS

1. The Examiner acknowledges receipt of the amendment filed 3/31/05 wherein the specification and claims 1, 25, 28, 30, and 33-35 were amended.

Note: Claims 1-36 are pending.

APPLICANT'S INVENTION

2. Applicant's invention is directed to biphenyl containing compounds and uses thereof.

RESPONSE TO APPLICANT'S ELECTION

3. It is duly noted that Applicant has submitted a proposed restriction in the response filed 4/8/08. The proposed restriction is acceptable to the Examiner. Thus, Applicant's election of Group IV in the proposed restriction is acknowledged.

Applicant's election is viewed as one without traverse since Applicant proposed the restriction themselves. In addition, the Examiner acknowledges receipt of the species Compound 2f depicted in Scheme 1 (X' is iodine, R10 is NR11R12, wherein both R11 and R12 are alkyl; and R7 and R8 are hydrogen).

The restriction is deemed proper and is made FINAL.

Notes: Proposed Group IV is directed to compounds of Formula II as set forth in claims 10-15 and 34 (in part). It should be noted that initially Applicant's elected species was searched. However, since no prior art was found which could be used to reject Applicant's elected species, the search was expanded to the species wherein one of R9 and R10 is hydroxylalkyl and the other is hydrogen; X' is Sn(alkyl)3; and R7 and R8

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together form a carbonyl. The search was not further expanded because prior art was found which could be used to reject the claims.

WITHDRAWN CLAIMS

4. Claims 1-9, 16-33, 35, and 36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

112 SECOND PARAGRAPH REJECTION

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10-15 and 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant is respectfully requested to submit a clean copy of the structure in independent claim 10. Specifically, the structure contains some bonds that are detached. (see the 5-membered ring. Also, it appears as if points R7 and R8 intersect at the 5-membered ring, but there are gaps in the structure. Please clarify structure.

Since claims 11-15 and 34 depend on claim 10, those claims are also ambiguous because of the missing bonds.

102 REJECTION

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 10 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenlee et al (US Patent No. 5,034,384).

Greenlee et al disclose antibacterial agents (see entire documents, especially, abstract). Specifically, in column 81, lines 15-24 (see Example 1) and column 82, lines 53-60 (see Example 2), two species are disclosed which are encompassed by Applicants Formula II. In particular, the structure in Example 1 encompasses the instant invention when **R9** is a hydroxylalkyl (CH₂-OH); **R10** is hydrogen; **X'** is Sn(alkyl)₃, specifically Sn(CH₃)₃; and **R7 and R8** together form a carbonyl). The structure in Example 2 encompasses the instant invention when **R9** is hydrogen; **R10** is a hydroxylalkyl (CH₂-OH); **X'** is Sn(alkyl)₃, specifically Sn(CH₃)₃; and **R7 and R8** together form a carbonyl). It should be noted that both Example 1 and Example 2 are directed to antibacterial compositions. Thus, both Greenlee et al and Applicant disclose overlapping subject matter.

COMMENTS/NOTES

9. It should be noted that no prior art has been cited for the elected species. Also, it is noted that the iodine in the elected species is radioactive as required in the last line of independent claim 10.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. Jones/
Primary Examiner
Art Unit 1618

July 6, 2008